

Atty. Dkt. No. 025782-0113 (f.k.a. 035451/0139)

REMARKS

Applicants respectfully request reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

Claims 1 and 9 are currently being amended.

This amendment adds, changes and/or deletes claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate defined status identifier.

After amending the claims as set forth above, Claims 1-25 are now pending in this application.

Claim Rejections – 35 U.S.C. § 112

In section 4 of the Office Action, the Examiner rejected Claims 1, 9, and 17 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The Examiner indicated that the claims contained subject matter which was described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. Applicants do not acquiesce in the Examiner's rejection. However, Applicants have amended independent Claims 1 and 9 to remove the asserted offending limitation. Accordingly, Applicants request the withdrawal of the § 112 rejection for Claims 1 and 9.

With regard to independent Claim 17, Applicants disagree with the Examiner in that the Examiner indicates that the phrase "thereby identifying the portable electronic device to the server" is not disclosed in the specification. However, Applicants submit that identifying the portable electronic device to the server is the essence of registration. This is well known in the art at the time of the invention that registration of a portable electronic device with a server includes identifying the portable electronic device to the server. Accordingly, Applicants respectfully request the withdrawal of the § 112 rejection of Claim 17.

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Claim Rejections – 35 U.S.C. § 103

In section 8 of the Office Action, the Examiner rejected Claims 1, 9, 11, 12 and 17 under 35 U.S.C. § 103(a) as being unpatentable over Macko (U.S. Patent No. 6,052,563) and in view of Pepe et al. (U.S. Patent No. 5,742,668). The Examiner states that Macko and Pepe disclose, teach, or suggest a combination of limitations including that the program is configured “to select at random a time within a predetermined interval to establish the wireless link, the predetermined interval being at least one of adjacent and around the predetermined time, the program also configured to send at the time, a registration message to an e-mail messaging service provider server to register the handheld computer with the server.”

Applicants respectfully submit that there is no teaching or disclosure in either of Macko or Pepe et al. which teaches selecting a random time which is around and close to a predetermined time in which to establish a wireless link with a server and send a registration message thereto for registering the handheld computer to the server. What is taught in Pepe et al. is sending a registration request to a server. Applicants respectfully submit that sending a registration message to a server was known at the time of the invention, however, the problem solved by Applicants' invention is that certain classes of devices were designed to attempt to register at the same time, which caused network congestion problems.

Therefore, providing a randomness to the specific time that the handheld computer will attempt to register with the server. All that is disclosed in Pepe et al. is that handheld computers may be registered with a server. There is nothing in Pepe et al. about registering the handheld computer at a particular time of day and having a random time for registering near the particular time in order to register the handheld computer at the random time. What is disclosed in Macko is only that e-mail messages may be delivered to an electronic communication device at various times. Nothing in Macko describes the process of registering at a random time the user's device.

Accordingly, Applicants respectfully submit that the process of registering the handheld computer and/or the communication device at a random time with a server is not disclosed, taught, or suggested by either of Macko or Pepe et al. alone, or in any proper

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combination. To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). With regards to Claims 1, 9, and 17, all of the claim limitations are not taught by either Macko or Pepe et al. alone, or in any proper combination, therefore, Applicants respectfully submit that Claims 1, 9, and 17 and their respective dependent claims are allowable.

Even if all of the claim limitations could be found in a combination of Pepe et al. or Macko, there is no desirability provided in either of Pepe et al. or Macko to combine the references in order to arrive at Applicants' invention of Claims 1, 9, and 17. Macko just teaches that e-mail messages can be delivered to communication devices at various times. What is taught in Pepe et al. is that a device can be registered with a server. There is not desirability provided to combine the two references. "The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification." In re Gordon, 733 F.2d at 902, 221 U.S.P.Q. 1125, 1127. Accordingly, Applicants respectfully submit that the Examiner has not provided a motivation to combine the references and therefore has not provided a prima facie case of obviousness. Thus, as stated earlier, Applicants respectfully submit that Claims 1, 9, and 17 and their respective dependent claims are allowable.

Applicants believe that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 06-1447. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 06-1447. If any extensions of time are needed for timely acceptance of

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papers submitted herewith, Applicants hereby petition for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 06-1447.

Respectfully submitted,

Date September 20, 2004

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